

Appl. No. 09/822,735
Amdt. Dated June 30, 2005
Reply to final Office action of April 15, 2005

REMARKS/ARGUMENTS

Claims 1-30 are pending in the present application.

This Amendment is to support the Request for Continued Examination (RCE) being filed concurrently in response to the final Office Action mailed April 15, 2005. In the final Office Action, the Examiner rejected claims 1-3, 5-13, 15-23, and 25-30 under 35 U.S.C. §102(e); and claims 4, 14, and 24 under 35 U.S.C. §103(a). Claims 1, 7-11, 18-21, and 28-30 have been amended. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

1. In the Office Action, the Examiner rejected claims 1-3, 5-13, 15-23, and 25-30 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. US2002/0081027A1 issued to Chatterjee et al. ("Chatterjee"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of anticipation. To anticipate a claim, the reference must teach every element of a the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Chatterjee discloses a method for electronic transport of digital ink. An image is formatted into a digital ink structure format (Chatterjee; paragraph [0018]). Then, the message is encoded into printable characters, such as ASCII characters (Chatterjee, paragraph [0018]). In the decoding process, each character is mapped to its 6 bit counterpart and the mapped result is concatenated to the partially decoded compressed data stream (Chatterjee, paragraph [0023]).

Chatterjee does not disclose, either expressly or inherently (1) a management layer to process data using a processing function; (2) the processing function is enabled or disabled by a configuration user interface; (3) a packetizer to packetize the string of data into at least one packet having a header identifying the first format as recited in claims 1, 8, 11, 18, 21, and 28; and (4) a detector to detect the second format as recited in claims 2, 12, and 22.

Appl. No. 09/822,735
Amtd. Dated June 30, 2005
Reply to final Office action of April 15, 2005

Chatterjee merely discloses formatting, compressing, and encoding. No packetizing is performed. Furthermore, the compressed digital ink stream includes a header and a compressed digital ink message (Chatterjee, paragraph [0028]). The header, therefore, is produced during the compressing, before the encoding. In contrast, the claimed invention provides the header during packetizing after the encoding. In addition, Chatterjee does not disclose that the header identifying the first format. Regarding claims 2, 12, and 22, Chatterjee does not disclose detecting the second format. Chatterjee merely discloses checking for a place keeper/end of message character (Chatterjee, paragraph [0023]), not detecting a second format.

Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §102(e) be withdrawn.

Rejection Under 35 U.S.C. § 103

2. In the Office Action, the Examiner rejected claims 4, 14, and 24 under 35 U.S.C. §103(a) as being unpatentable over Chatterjee in view of U.S. Patent No. 6,741,749 issued to Herbert, Jr. ("Herbert"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004). Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Chatterjee discloses a method for electronic transport of digital ink as discussed above. Herbert discloses a system device, computer program product, and method for representing a plurality of electronic ink data points. Pen-enabled computing systems capture handwriting input. The handwritten information may be bodily incorporated into messages, such as email messages, facsimiles, instant messages and the like (Herbert, col. 5, lines 1-5).

Appl. No. 09/822,735
Amndt. Dated June 30, 2005
Reply to final Office action of April 15, 2005

Chatterjee and Herbert, taken alone or in any combination, does not disclose, suggest, or render obvious (1) a management layer to process data using a processing function; (2) the processing function is enabled or disabled by a configuration user interface; (3) a packetizer to packetize the string of data into at least one packet having a header identifying the first format as recited in claims 1, 8, 11, 18, 21, and 28; and (4) a detector to detect the second format as recited in claims 2, 12, and 22, and (5) a network having an instant messaging infrastructure. There is no motivation to combine Chatterjee and Herbert because neither of them addresses the problem of transmitting new data format under existing infrastructure. There is no teaching or suggestion that a packet transmitted to a network having an instant messaging infrastructure is present.

Chatterjee, read as a whole, does not suggest the desirability of an instant message infrastructure.

Chatterjee does not disclose or suggest packetizing the string of data, a management layer, a processing function which may be enabled/disabled as discussed above. Herbert merely discloses representing a series of electronic ink data points to reduce the storage capacity (Chatterjee, col. 5, lines 24-27), not encoding data in a first format into a string of data in the second format.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Here, Chatterjee discloses inserting the encoded digital ink segment in an email message (Chatterjee, paragraph [0022]). The encoded messages uses ASCII characters. In contrast, Herbert discloses representing the plurality of data points by high-order derivatives (Herbert, col. 9, lines 11-13). Modifying Chatterjee to incorporate the teaching of Herbert implies that the message must be encoded by high-order derivatives which are incompatible with ASCII text message. Therefore, it cannot be inserted in an email message, rendering Chatterjee's invention being unsatisfactory for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification.

Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejections under 35 U.S.C. §102(e), and 35 U.S.C. §103(a) be withdrawn.

Appl. No. 09/822,735
Amdt. Dated June 30, 2005
Reply to final Office action of April 15, 2005

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: June 30, 2005

By 
Thinh V. Nguyen
Reg. No. 42,034
Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

FACSIMILE

deposited with the United States Postal Service
as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

transmitted by facsimile to the Patent and
Trademark Office.

Date: June 30, 2005

June 30, 2005

Tu Nguyen

Date